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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/801,892  | 03/16/2004  | Victor Paul Eliu     | HP/5-22861/A        | 3368             |
| 7590  | 04/03/2006  |                      | EXAMINER            |                  |
| Patent Department<br>Ciba Specialty Chemicals Corporation<br>540 White Plains Road<br>P.O. Box 2005<br>Tarrytown, NY 10591-9005 |             |                      | ELHILLO, EISA B     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1751                |                  |
| DATE MAILED: 04/03/2006   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                            |  |  |
|---|----------------------------|--|--|
| <b>Office Action Summary</b>  | Application No.            | Applicant(s)   |  |
|   | 10/801,892                 | ELIU ET AL.  |  |
|   | Examiner<br>Eisa B. Elhilo | Art Unit<br>1751   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |                            |  |  |
| <b>Period for Reply</b>   |                            |  |  |
| <b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</b>  |                            |  |  |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                            |  |  |
| <b>Status</b>   |                            |  |  |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>16 March 2004</u> .   |                            |  |  |
| 2a) <input type="checkbox"/> This action is <b>FINAL</b> .                            2b) <input type="checkbox"/> This action is non-final.  |                            |  |  |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.   |                            |  |  |
| <b>Disposition of Claims</b>  |                            |  |  |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-18</u> is/are pending in the application.  |                            |  |  |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration.  |                            |  |  |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.  |                            |  |  |
| 6) <input type="checkbox"/> Claim(s) _____ is/are rejected.   |                            |  |  |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.  |                            |  |  |
| 8) <input checked="" type="checkbox"/> Claim(s) <u>1-18</u> are subject to restriction and/or election requirement.   |                            |  |  |
| <b>Application Papers</b>   |                            |  |  |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.   |                            |  |  |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.   |                            |  |  |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).   |                            |  |  |
| Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  |                            |  |  |
| 11) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.   |                            |  |  |
| <b>Priority under 35 U.S.C. § 119</b>   |                            |  |  |
| 12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  |                            |  |  |
| a) <input type="checkbox"/> All    b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:  |                            |  |  |
| 1. <input type="checkbox"/> Certified copies of the priority documents have been received.  |                            |  |  |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.   |                            |  |  |
| 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  |                            |  |  |
| * See the attached detailed Office action for a list of the certified copies not received.  |                            |  |  |
| <b>Attachment(s)</b>  |                            |  |  |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  |                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  |                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____.   |                            | 6) <input type="checkbox"/> Other: _____.  |  |

## DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a chemical compound, variously classified in class 548 and several subclasses.
  - II. Claims 6-7, drawn to a process for preparation a chemical compound, classified in various classes of 544, 546, 548 564 and several subclasses.
  - III. Claims 8-18, drawn to a dyeing composition and its method for using, classified in class 8, subclass 405.

The inventions are distinct, each from the other because of the following reasons:

2 Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other materially different product in which A can be selected from cationic pyridinium or cationic imedazolium radicals.

3 Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product (compound) having cationic pyridine radical or cationic imedazole radical.

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4 Inventions II and III are related as process of making and process of using the product.

The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

5 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6 A telephone call was made to Kevin T. Mansfield on March 30, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo  
Primary Examiner  
Art Unit 1751

March 30, 2006